

Remarks

Reconsideration of this Application is respectfully requested. This amendment cancels claim 8 and amends claims 9 and 10. No new matter has been added.

Applicant respectfully requests that the Examiner initial and return a copy of the Form PTO-1449 filed along with the First Supplemental Information Disclosure Statement filed on April 7, 2004. Attached is a copy of a post card receipt date stamped April 7, 2004, evidencing the filing of this First Supplemental Information Disclosure Statement.

Applicant notes with appreciation that the Examiner has found claims 1-7 allowable.

Upon entry of the foregoing amendment, claims 1-7 and 9-11 are pending in the application, with claim 1 being the independent claim. Claim 8 is sought to be canceled without prejudice to or disclaimer of the subject matter therein. Claims 9 and 10 are sought to be amended. Support for the amendments can be found in the original specification and claims as filed. These changes are believed to introduce no new matter, and their entry is respectfully requested. Applicant asserts the right to file one or more continuing applications directed to the subject-matter of the canceled claim 8 and to the subject-matter canceled from claims 9 and 10.

Specifically, claim 9 has been amended by deleting the phrase ", ameliorating or preventing". Claim 10 has been amended by deleting the phrase ", preventing or ameliorating". No new matter has been introduced by these amendments.

Based on the above amendment and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejection Under 35 U.S.C. § 112, first paragraph

The Examiner has rejected claims 8-11 under 35 U.S.C. § 112, first paragraph, because, according to the Examiner, the specification while being enabling for treating pain, does not reasonably provide enablement for preventing or ameliorating pain and treating disorders responsive to the excitation of μ opioid receptors. The Examiner states that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. Applicant respectfully traverses this rejection.

In order to expedite the prosecution of the pending claims, Applicant has canceled claim 8. Also, the terms "preventing" and "ameliorating" have been deleted from claims 9 and 10.

In view of the above, reconsideration and withdrawal of the rejection of claims 8-11 under 35 U.S.C. § 112, first paragraph, are respectfully requested.

Rejection Under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claims 8-11 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant respectfully traverses this rejection.

Specifically, the Examiner states that in claim 8, "the term ---disorder responsive to excitation of mu opioid receptors---- is indefinite" and in claims 9-11 "the terms ---preventing and ameliorating--- are indefinite." In order to expedite the prosecution of the pending claims, Applicant has canceled claim 8 and deleted the terms "preventing" and "ameliorating" from claims 9 and 10. Claim 11 does not recite neither "preventing" nor "ameliorating."

In view of the above, reconsideration and withdrawal of the rejection of claims 8-11 under 35 U.S.C. § 112, second paragraph, are respectfully requested.

Allowable Subject Matter

The Examiner has indicated that the instant compounds of Formula I, pharmaceutical compositions containing these compounds and a method of treating pain using these compounds are allowable over the prior art.

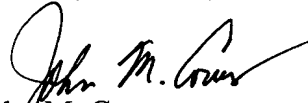
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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